

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

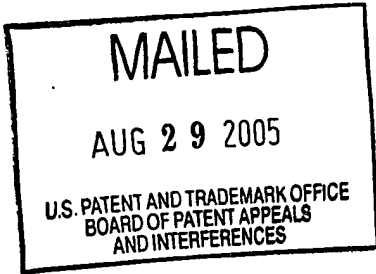
Ex parte SANTOKH S. BADESHA
and
EDWARD L. SCHLUETER, JR.

Application 09/737,413

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on July 27, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith electronically returned to the examiner. The matters requiring attention prior to docketing are identified below.

An examination of the record indicates that in the Final Rejection mailed August 12, 2003, the following § 103 rejections were made:



1. Claims 1-10 and 13-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Badesha et al. (U.S. 5,846,643) in view of Swift et al (U.S. 6,381,436) [page 2]; and

2. Claims 1-17 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badesha et al (U.S. 5,846,643) in view of Badesha et al. (U.S. 6,482,504) [page 4].

Appellants reiterate these grounds on pages 6-11 of their Appeal Brief January 12, 2004. The Examiner's Answer mailed April 21, 2004 also concurs with the above two rejections. However, in the discussion of the second rejection appearing on page 12 of the Answer, the examiner includes the Swift reference. It appears that the addition of the Swift reference to the § 103(a) rejection of claims 1-17 and 20-21 is a new ground of rejection.

At the time the Examiner's Answer was mailed, 37 CFR § 1.93(a)(2) prohibited the entry of a new ground of rejection. See § 1208.01 of the Manual of Patent Examining Procedure (MPEP) (Eighth Edition, Aug. 2001), which states:

37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new

ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).

Accordingly, it is

ORDERED that the application is returned to the examiner to:

- 1) vacate the Examiner's Answer mailed April 21, 2004;
- 2) to select one of the following options:
 - a) reopen prosecution;
 - b) write a new Examiner's Answer without the new ground of rejection; or
 - c) write a new Examiner's Answer properly setting forth the new ground of rejection; and
- 3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

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CRF:psb

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